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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,053	10/07/2003	Tommy Grigsby	2003-IP-009526 U1 USA	8290

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07/06/2005

Marlin R. Smith
KONNEKER & SMITH
Suite 230
660 N. Central Expressway
Plano, TX 75074

EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT

PAPER NUMBER

3672

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,053

Applicant(s)

GRIGSBY ET AL.

Examiner

Jennifer H. Gay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-19 and 21-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-19 and 21-29 is/are allowed.
- 6) ☒ Claim(s) 1, 30-34 and 39 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 5-10 and 35-38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/22/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 30-32 and 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Bixenman et al. in view of Patel (US 6,684,950).

Regarding claim 30: Bixenman et al. discloses a system for completing a wellbore. The system includes the following features:

- A first assembly installed in the wellbore where the first assembly includes a fluid control device **14** and a first fiber optic line.
- A second assembly **12** installed in the wellbore and engaged with the first assembly where the second assembly includes a second fiber optic line (Figure 6).

Bixenman et al. discloses all of the limitations of the above claims except for the first assembly including a fluid loss control device that prevents flow until the second assembly is engaged with the first assembly.

Patel discloses a wellbore fluid loss control device. The device **300** is located on a first assembly **32** and prevents flow through the first assembly until a second assembly **44** engages the first assembly (Figure 6).

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified Bixenman et al. to include a fluid loss control device as taught by Patel in order to have prevented flow through the apparatus until the entire apparatus was assembled. This would have allowed characteristics of the produced fluid to be measured after the chain of fiber optic cables were connected.

Regarding claim 31, 32: The fluid control device is a valve that selectively permits fluid flow through the production tubing and into the wellbore through a well screen **18** of the first assembly.

Regarding claim 39: The fluid loss control device of Patel permit one-way flow through the device.

3. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bixenman et al. in view of Patel as applied to claim 30 above, and further in view of Wetzel et al. (US 2004/0173350).

Bixenman et al. and Patel disclose all of the limitations of the above claims except for the first fiber optic line extending longitudinally through the well screen and packer of the first assembly.

Wetzel et al. discloses a system similar to that of Bixenman et al. Wetzel et al. further teaches a gravel packing assembly that includes a wellbore screen **28** through which a fiber optic line **60** may extend longitudinally (paragraphs 0034-0037). The fiber optic line of Wetzel et al. may also extend longitudinally within the sidewall of the well screen. Wetzel et al. also teaches a packer **24, 30, and 42** through which the fiber optic line **60** extends (Figure 1).

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the system of Bixenman et al. in view of Patel such that the fiber optic line extended through the well screen and packer as taught by Wetzel et al. in order to have provided a means for filtering the fluid entering the wellbore. This would have reduced the wear on the various pieces of equipment in the wellbore as well as the need for surface equipment to remove debris from the produced fluid. Further, the fiber optic line would have been protected from any debris in the produced fluid.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of copending Application No. 10/680,625. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 4 of Application No. 10/680,625 recite essentially the same limitations that are recited in claim 1 of the instant application and could be used to reject claim 1 if the application qualified as prior art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

6. Claims 11-19 and 21-29 are allowed.

7. Claims 2, 3, 5-10, and 35-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 20 May 2005 have been fully considered but they are not persuasive.

The examiner would first like to respond to the argument against the Double Patenting rejection of claim 1 presented in the previous response of 13 January 2005 and apologize for not responding to this argument in the previous Office Action. Indeed, the rejection itself was inadvertently left out of the previous Office Action.

Applicant had argued that the provisional double patenting rejection of claim 1 should be withdrawn if it was the only rejection remaining in the application. Firstly, other rejections of the claims remain in the case thus the inclusion of the double patent rejection is proper. Further, the copending application, Application No. 10/680,625, does not include a double patenting rejection over the instant application. Section 822.01 of the MPEP requires that a double patenting rejection be maintained in one of two applications where provisional double patenting exists. Since the copending application does not include a double patenting rejection over the instant application, the inclusion of the double patenting rejection is proper.

Applicant has argued that the device of Patel does not operate in response to the connecting of assemblies downhole and instead the device opens as tubing is lowered into the well and then closes to permit testing. Applicant further argues that there is not disclosure or suggestion in Patel of a fluid loss control device, which is operative in response to the downhole engagement of two assemblies.

The examiner first notes that claim 30, the claim in question, does not recite that the device is "operative" as a result of the engagement but merely that the device "permits flow" in response to the engagement of the two assemblies. Patel clearly teaches a flow control device that "permits flow" after the engagement of the two assemblies.

Further, claim 30 does not exclude the device from closing again once the assemblies are engaged. The claim merely recites that the device "permits flow" or is opened as a result of the engagement, which is taught by Patel.

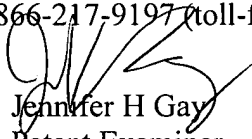
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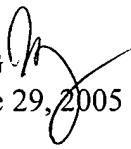
Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H. Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer H Gay
Patent Examiner
Art Unit 3672

JHG 
June 29, 2005